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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,200	07/22/2003	Chuan-Yu Hsu	JCLA5184-CA	1800

43831 7590 12/26/2006  
BERKELEY LAW & TECHNOLOGY GROUP  
1700NW 167TH PLACE  
SUITE 240  
BEAVERTON, OR 97006

EXAMINER
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GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/26/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/626,200

Applicant(s)

HSU ET AL.

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 6-9 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-9 and 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT  
PRIMARY EXAMINE

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **Detailed Action**

**1.**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 1, 6-9 , 14-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lo.

With regard to claims 1 and 17, Lo teaches a method implemented on a computer system having a user interface, the computer system running a scanner driver and an application program; the method comprising the steps of: storing a set of default image processing settings in the user interface (client computer sets processing range setting, see col. 12, lines 10-40 (especially lines 31-40); activating the scanner , via scanner server 130, to perform a primitive scan operation on a document to obtain a primitive scanned image which is then transferred to the scanner driver, see col. 16, lines 12-40; activating the scanner driver (Twain device driver) to perform a set of image processing routines on the primitive scanned image to thereby obtain the image qualities of the original document (col. 5, lines 48-57); specifying a set of unique image processing settings for optimal scan of the original document (see col. 16, lines 55-62); and activating the scanner to perform a final scan operation on the document in accordance with the specified image processing settings.

With respect to claims 6 and 18 and 14, see col. 15, lines 47-56.

With respect to claims 7, 15 and 19, see col. 15, lines 47-56, see also col. 13, lines 45-69 for software controlling the Twain device driver.

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With respect to claims 8, 16 and 20, Lo teaches processing the text and image if text is part of the data scanned by scanner 144.

With respect to claim 9, Lo teaches a user interface implemented on a computer system, the computer system adapted to execute a scanner driver and an application program; the user interface (client computer keyboard) comprising: means for storing a set of default image processing settings in the user interface (client computer sets processing range setting, see col. 13, lines 10-40; activating the scanner (via scanner server 130) to perform a primitive scan operation on a document based on a primitive scanned image which is then transferred to the scanner driver, see col. 16, lines 12-40;

executing the scanner driver (Twain device driver) to perform a set of image processing routines on the primitive scanned image to thereby obtain the image qualities of the original document (col. 5, lines 48-57) and based on the image qualities of the original document;

obtaining a set of unique image processing settings for optimal scan of the original document (see col. 16, lines 55-62) based at least in part on the obtained image qualities; and activating the scanner to perform a final scan operation on the in accordance with the specified image processing settings.

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With respect to claims 21 and 23 Lo teaches a computer system coupled with a scanner for performing an automatic scan operation on an original document, the computer system executes a scanner driver and an application program;

With respect to claims 22 and 24, Lo teaches activating the scanner to perform a final scan operation on the original document based on the suited image processing settings to thereby obtain a final scanned image which is transferred to the application program for use by the application program, see col. 16, lines 55-60).

2.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Instructions on a storage medium do not fall under the category of inventions that are afforded patent protection. See MPEP 2106.01

3. Examiner's Remarks

Applicant's remarks have been considered but are unpersuasive. Applicant alleges that Lo does not teach the execution of the scanner driver to perform a set of image processing routines on the primitive scanned image to obtain the image qualities of the document.

Applicant offers no support for this contention. The examiner, however, has relied upon specific recitations in the Lo reference. For example, the examiner relied upon col. 5 lines 48-57 and col. 16, lines 12-40.

Neither was reference made to the aforementioned sections of Lo as to how they did not teach the inventive feature. Applicant's contentions appear to be mere allegations.

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4.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



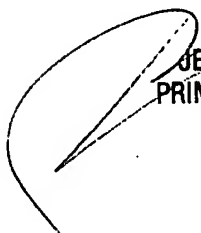
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5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 JEROME GRANT  
PRIMARY EXAMINER